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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/927,288	08/10/2001	Sanjay Chaturvedi	A01085A	4959

21898 7590 06/18/2003
ROHM AND HAAS COMPANY
PATENT DEPARTMENT
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EXAMINER

OH, TAYLOR V

ART UNIT	PAPER NUMBER
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1625

DATE MAILED: 06/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/927,288

Applicant(s)

CHATURVEDI ET AL.

Examiner

Taylor Victor Oh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4 and 5 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4-5 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

Final Rejection

The Status of Claims

Claims 4-5 are pending.

Claims 4-5 have been rejected.

Claims 1-3 and 6-10 have been canceled.

Claim Rejections-35 USC 112

1. Applicants' argument filed 4/2/2003 have been fully considered but they are not persuasive.

The rejection of Claims 4-5 has been maintained due to applicants' failure to modify in the amendment.

Double Patenting Rejection

The rejection of Claims 1, 3-5, and 8 provisionally under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 and 7-8 of copending Application No. 10/095,633 or 09/928,020 has been withdrawn due to the modification made in the amendment.

Claim Rejections-35 USC 102

The rejection of Claims 1-3, 5, and 8 under 35 U.S.C. 102(a) as being anticipated clearly by Komada et al (U.S. 6,043,186) has been withdrawn due to the modification made in the amendment.

Response to Argument

2. The applicants argue the following issue:

1. applicants are not required to present any examples at all according to the C.C.P.A. which stated that the claims may be supported either by the use of illustrative examples or by broad terminology;"
2. the catalyst composition rejection based on Ex parte Sizto can not make a general statement about unpredictability within a particular class of catalysts.

The applicants' arguments have been noted, but these arguments are not persuasive.

First, with regard to the first argument, the Examiner has noted applicants' argument. However, in the instant case, the claims encompass the various combination of hundreds of catalysts represented in the empirical formula, but they are not directed to the group of specific compounds. Furthermore, applicants' specification provide the only 9 particular exemplified catalyst compounds. There is no showing that all the possible combinational catalyst systems would work for the claimed invention. Thus, the examples herein have failed to provide sufficient working examples to support the production of hundreds of catalyst compositions represented in the empirical formula.

Second, regarding the second argument, the Examiner has noted applicants' argument. However, the decision based on *Ex parte Sizto* can be generally applied to any catalyst compositions regardless of enzyme and non-enzyme catalysts because it deals with the unpredictable nature of catalysts in the art of organic chemistry when they are involved in the reaction process due to various reaction conditions. In addition, applicants' catalyst compositions are not just the particular class of catalysts, but the various combination of hundreds of catalysts represented in the empirical formula. Therefore, it is certain that there is unpredictability using the unproven catalyst compositions.

Therefore, the rejection of claims 4 and 5 is maintained.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taylor Victor Oh whose telephone number is 703-305-0809. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alan Rotman can be reached on 703-308-4698. The fax phone numbers

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for the organization where this application or proceeding is assigned are 703-308-2742 for regular communications and 703-305-7401 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.



ALAN L. ROTMAN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600